

### **REMARKS**

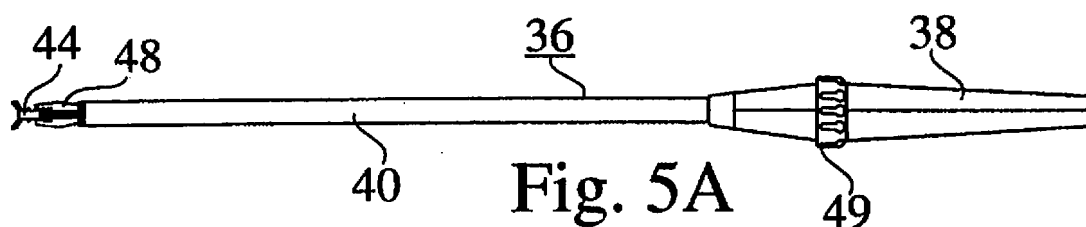
The above-identified application has been considered in view of the Office Action that was mailed on January 16, 2009. Claims 10-28 are currently pending. By the present Amendment, Applicants have amended claims 10-12, 21, and 25-27. Applicants respectfully submit that these amendments do not introduce any new subject matter, and are fully supported by the specification as originally filed. In view of the amendments to the claims effected herein, and the following remarks and arguments, Applicants respectfully submit that claims 10-28 are allowable over the references of record, and accordingly, respectfully request reconsideration and allowance of these claims.

Claims 10, 11, 14-19, and 22-28 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,290,299 to Fain, *et al.* (hereinafter “Fain”). Applicants respectfully submit, however, that Fain fails to disclose each and every element recited in claims 10, 11, 14-19, and 22-28 as presented herein.

Amended independent claim 10 recites “[a]n apparatus for substantially closing a vascular opening in a vessel” that includes, *inter alia*, “a housing having proximal and distal ends, and defining a longitudinal axis,” and “at least two tissue engaging members . . . each having a distal segment arranged in a general hook or J-shaped configuration, said distal segments being disposed in general diametrical opposed relation and generally curving away from the longitudinal axis when said tissue engaging members are in said advanced position.”

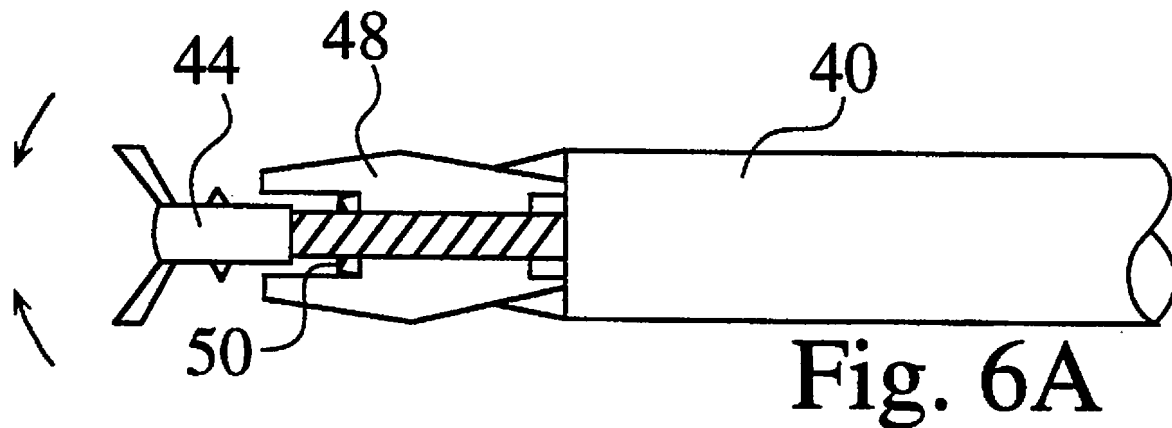
Amended independent claim 25 recites “[a]n apparatus for substantially closing a vascular opening in a vessel” that includes, *inter alia*, “a housing defining a longitudinal axis,” and “a pair of tissue engaging members . . . having tissue contacting segments . . . the tissue contacting segments having arcuate segments curving away from the longitudinal axis and in diametrical opposed relation when the tissue engaging members are in the advanced position.”

Fain relates to “a method and apparatus for attaching implanted materials or devices to tissue inside the body.” (Col. 1, lines 9-11). In one embodiment, Fain describes a fastening tool 36 for applying a plurality of fasteners 20, 22 to tissue. (See col. 4, lines 45-47, 67; see FIGS. 1, 2; see FIG. 5A reproduced below). The fastening tool 36 includes “a handle 38 at its proximal end, a shaft 40 extending forwardly from handle 38, a lever 42 carried by the handle 38 for actuating a first pair of jaws 44, and a trigger 46 carried by handle 38 for actuating a second pair of jaws 48.” (Col. 4, line 68 – col. 5, line 4; see FIG. 5A reproduced below).



In the Office Action, the jaws 44 of the Fain instrument were characterized as the recited “tissue engaging members.” However, as seen in FIG. 5A above, as well as in FIG. 6A below, the jaws 44, as well as the jaws 48 for that matter, are substantially linear in configuration. As such, Applicants respectfully submit that Fain fails to disclose “at least two tissue engaging members . . . each having a distal segment arranged in a general

hook or J-shaped configuration,” as recited in amended independent claim 10, or even suggest that such would be desirable. Likewise, Applicants respectfully submit that Fain also fails to disclose, or even suggest, “a pair of tissue engaging members . . . having tissue contacting segments . . . the tissue contacting segments having arcuate segments curving away from the longitudinal axis,” as recited in amended independent claim 25.



For at least this reason, *inter alia*, Applicants respectfully submit that Fain fails to disclose each and every element recited in amended independent claims 10 and 25, and consequently, that amended independent claims 10 and 25 are allowable over Fain under 35 U.S.C. §102(b). Since claims 11, 14-19, 22-24, and 26-28 depend either directly or indirectly from amended independent claims 10 and 25, and include each element recited therein, for at least the reasons that amended independent claims 10 and 25 are allowable over Fain under 35 U.S.C. §102(b), *inter alia*, Applicants respectfully submit that claims 11, 14-19, 22-24, and 26-28 are also allowable over Fain under 35 U.S.C. §102(b).

Claim 20 was rejected under 35 U.S.C. §103(a) as being unpatentable over Fain. Applicants respectfully submit, however, that Fain fails to suggest the subject matter of claim 20 as a whole.

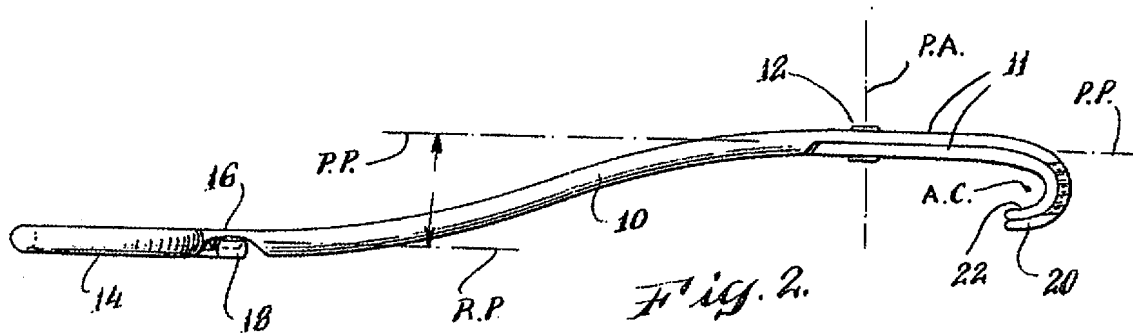
In the Office Action, it was acknowledged that Fain fails to disclose “a spring member in engagement with said actuator to bias said jaw members towards the closed position,” as recited in claim 20, but it was argued that incorporating such a member to bias the jaw members would have been obvious to one of ordinary skill in the art at the time the claimed subject matter was invented.

As previously discussed, Fain fails to disclose, or even suggest, the “at least two tissue engaging members . . . each having a distal segment arranged in a general hook or J-shaped configuration” recited in amended independent claim 10. Assuming, *arguendo*, that it would have been obvious to incorporate a spring or other such biasing member into the fastening tool disclosed in Fain, as alleged in the Office Action, the incorporation of such a biasing member would fail to cure this deficiency.

Accordingly, and for at least this reason, *inter alia*, Applicants respectfully submit that Fain fails to suggest the subject matter of amended independent claim 10 as a whole, and therefore, that amended independent claim 10 is allowable over Fain under 35 U.S.C. §103(a). Since claim 20 depends indirectly from amended independent claim 10, and includes each element recited therein, for at least the reasons that amended independent claim 10 is allowable over Fain under 35 U.S.C. §103(a), *inter alia*, Applicants respectfully submit that claim 20 is also allowable over Fain under 35 U.S.C. §103(a).

Claims 12 and 13 were rejected under 35 U.S.C. §103(a) over Fain in view of U.S. Patent No. 3,364,933 to Leopold (hereinafter "Leopold"). Applicants respectfully submit, however, that the combination of Fain and Leopold fails to suggest the subject matter of claims 12 and 13 as a whole.

Leopold relates to a "slidable surgical clamp having two arms joined together for relative axial movement in a pivoting plane." (Col. 1, lines 10-11). In one embodiment, the described clamp includes "crossed elongated forcep arms 10 centrally joined by a pivot screw 12," (col. 2, lines 2-3), which terminate in overlapping jaws 20, 22. (See col. 2, lines 22-24; see FIG. 2 reproduced below).



In the Office Action, it was acknowledged that Fain fails to disclose tissue engaging members including "hook or J-shaped" portions, as substantially recited in amended independent claim 10, and Leopold was relied upon for disclosure of this concept, with particular reference to FIG. 2 above.

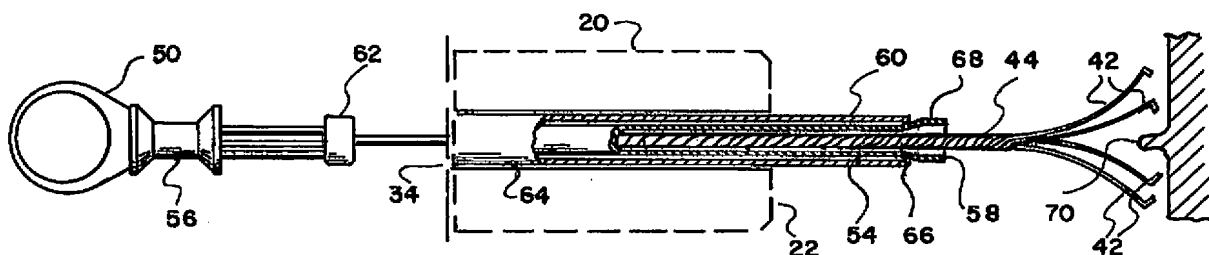
As seen in FIG. 2, the curvature of the overlapping jaws 20, 22 is the same. That is, the jaws 20, 22 curve in the same direction relative to the longitudinal axis of the clamp. In fact, it is this semblance in curvature that allows the jaws 20, 22 to

overlap, and thus clamp tissue therebetween in accordance with the principles of the Leopold disclosure.

In contrast, amended independent claim 10 recites “at least two tissue engaging members . . . each having a distal segment arranged in a general hook or J-shaped configuration, said distal segments being disposed in general diametrical opposed relation and generally curving away from the longitudinal axis when said tissue engaging members are in said advanced position.” Were the jaws 20, 22 of the Leopold clamp to be curved as claimed, i.e., in “general diametrical opposed relation,” the jaws 20, 22 would be unable to clamp tissue therebetween as discussed in the written description of Leopold, thus frustrating the very purpose of the instrument.

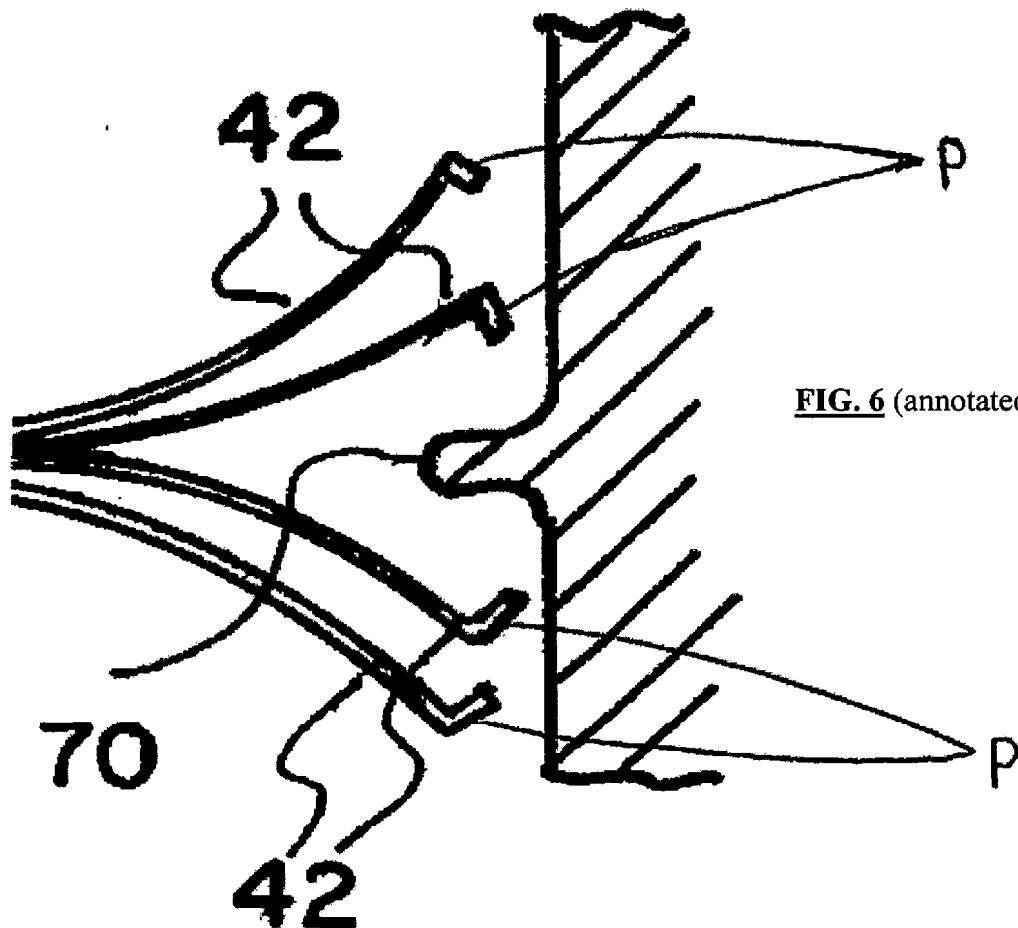
Therefore, Applicants respectfully submit that Leopold fails to remedy the deficiencies in Fain identified and acknowledged in the Office Action. Accordingly, and for at least this reason, *inter alia*, Applicants respectfully submit that the combination of Fain and Leopold fails to suggest the subject matter of amended independent claim 10 as a whole, and consequently, that independent claim 10 is allowable over Fain in view of Leopold under 35 U.S.C. §103(a) as presented herein. Since claims 12 and 13 depend indirectly from amended independent claim 10, and include each element recited therein, for at least the reasons that amended independent claim 10 is allowable over Fain in view of Leopold under 35 U.S.C. §103(a), *inter alia*, Applicants respectfully submit that claims 12 and 13 are also allowable over Fain in view of Leopold under 35 U.S.C. §103(a).

Petruzzi relates to a “forceps-like assembly adapted for use in conjunction with endoscopic instruments; and a method for the grasping/manipulation of objects within a bodily cavity by such endoscopic instruments.” (Col. 1, lines, 12-15). In one embodiment of the disclosure, Petruzzzi describes an instrument 32 including a plurality of fingers 42 that are spring biased apart. (*See* col. 4, lines 51-53; *see* FIG. 3; *see* FIG. 6 reproduced below). The instrument 32 further includes a sheath 54 that is movable over the fingers 42 to force them inwardly into a closed position to grasp an object 70. (*See* col. 4, line 60 – col. 5, line 4; *see* FIG. 6 reproduced below).



In the Office Action, it was acknowledged that Fain fails to disclose tissue engaging members curving in opposite directions, as substantially recited in claim 21, and Petruzzi was relied upon for disclosure of this concept, with particular reference to FIG. 6 above.

The only structure in Petruzzi that may be arguably characterized as having a “general hook or J-shaped configuration,” a feature of the “tissue engaging members” recited in amended independent claim 10, lies at the distal-most ends of the fingers 42, i.e., the projections identified by the reference character “P” in the annotated enlargement of FIG. 6 below, in that the fingers 42 themselves do not engage, grasp, or facilitate the manipulation of tissue at all. However, in addition to being linear, and therefore, not of a “general hook or J-shaped configuration,” the projections “P” extend towards the longitudinal axis of the instrument 32, rather than “curving away from the longitudinal axis,” an additional feature recited in amended independent claim 10.





In fact, were the projections “P” directed “away from the longitudinal axis” in accordance with the recitation in amended independent claim 10, the fingers 42 would be unable to perform the grasping function identified in the written description of Petruzzi. As such, Applicants respectfully submit that Petruzzi not only fails to disclose “at least two tissue engaging members . . . each having a distal segment arranged in a general hook or J-shaped configuration, said distal segments being disposed in general diametrical opposed relation and generally curving away from the longitudinal axis when said tissue engaging members are in said advanced position,” as recited in amended independent claim 10, but in fact teaches away from the claimed subject matter, instead disclosing linear projections that extend towards the longitudinal axis of the instrument with which they are associated.

Therefore, Applicants respectfully submit that Petruzzi fails to remedy the deficiencies in Fain identified and acknowledged in the Office Action. Accordingly, and for at least this reason, *inter alia*, Applicants respectfully submit that the combination of Fain and Petruzzi fails to suggest the subject matter of amended independent claim 10 as a whole, and consequently, that independent claim 10 is allowable over Fain in view of Petruzzi under 35 U.S.C. §103(a) as presented herein. Since claim 21 depends directly from amended independent claim 10, and includes each element recited therein, for at least the reasons that amended independent claim 10 is allowable over Fain in view of Petruzzi under 35 U.S.C. §103(a), *inter alia*, Applicants respectfully submit that claim 21 is also allowable over Fain in view of Petruzzi under 35 U.S.C. §103(a).

Claim 10 was rejected on the ground of non-statutory obviousness-type double patenting over claim 1 of U.S. Patent No. 6,248,124 (hereinafter “the ‘124

patent”). Applicants respectfully submit, however, that independent claim 10, as presented herein, recites subject matter that is patentably distinguishable from the subject matter recited in claim 1 of the ‘124 patent. For example, claim 1 of the ‘124 patent fails to recite “at least two tissue engaging members . . . each having a distal segment arranged in a general hook or J-shaped configuration, said distal segments being disposed in general diametrical opposed relation and generally curving away from the longitudinal axis when said tissue engaging members are in said advanced position,” as currently recited in amended independent claim 10.

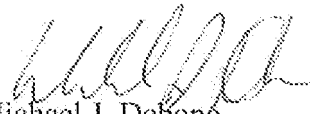
Given this difference, Applicants respectfully submit that the subject matter recited in amended independent claim 10 is patentably distinct from that recited in claim 1 of the ‘124 patent. Accordingly, Applicants respectfully submit that the rejection of claim 10 on the ground of non-statutory obviousness-type double patenting over claim 1 of the ‘124 application is legally insufficient, and as such, respectfully request withdrawal of the rejection.

In view of the amendments to the claims effected herein, and the foregoing remarks and arguments, Applicants respectfully submit that claims 10-28 are allowable over the references of record, and accordingly, respectfully request reconsideration and allowance of these claims.

Should the Examiner have any questions concerning this Amendment, or feel that an interview would be helpful in resolving any outstanding matters, the Examiner is sincerely invited to contact Applicants’ undersigned attorney at the number indicated below.

Please charge any deficiency, as well as any other fee(s) which may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s), to Deposit Account No. 21-0550. Also, in the event that any extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required, and charge Deposit Account No. 21-0550 therefor.

Respectfully submitted,

  
Michael J. Debono  
Reg. No. 62,877  
Attorney for Applicants

***Carter, DeLuca, Farrell & Schmidt, LLP***  
445 Broad Hollow Road, Suite 420  
Melville, New York 11747  
Tel.: (631) 501-5700  
Fax: (631) 501-3526

**Send correspondence to:**  
Chief Patent Counsel  
COVIDIEN  
60 Middletown Avenue  
North Haven, Connecticut 06473